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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,367	03/09/2004	Guy J. Rackham	END920030163US1	2245
7590 John R. Pivnichny IBM Corporation Dept IQ0A, Bldg. 40-3 1701 North Street Endicott, NY 13760			EXAMINER CHONG CRUZ, NADJA N	
			ART UNIT 3623	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,367

Applicant(s)

RACKHAM, GUY J.

Examiner

NADJA CHONG CRUZ

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This Final action is in reply to the response filed on 30 September 2008.
2. Claim 22 have been amended.
3. Claims 1-21 and 23-25 have been cancelled.
4. Claim 22 are currently pending and have been examined.
5. The rejections of claims 22 have been updated to reflect the amendments.

Response to Amendment

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.
7. The rejection of claims 1-21, 23 and 24 under 35 USC § 101 is withdrawn in light of Applicant's amendment.

Response to Arguments

8. Applicant's arguments received on 30 September 2008 have been fully considered but are not persuasive.
9. With regard to claim 22, Applicant argues that the prior art of record, specifically that Northcott (1) *does not describe this filtering step*; (2) *does not describe selecting a plurality of target tasks and therefore does not map a plurality of target tasks into a heat map of selected components* (page 5, first paragraph); (3) *does not describe or suggest implicitly or otherwise a competency lens having offerings of these four strategies now required by claim 22* (page 5, second paragraph) and that Northcott neither Lindsay-Scott describe (4) *patterns to be applied to the selected components to model how the selected components collaborate* (page 5, last paragraph).
10. In response to arguments (1) and (2). Examiner respectfully disagrees. Northcott teaches "[t]he step of identifying a potential point of intervention may comprise selecting (e.g., filtering) a potential target task from the tasks" (e.g., a map of components of activities) "in the

representative process map based at least in part upon one or more of the estimated unit cost values, incidence rates, total costs, and outcomes. The potential target task may be mapped into a network of one or more sub-tasks." Northcott teaches a selection of a potential target task based at least in part from one or more of the estimated unit cost values, incidence rates, total costs and outcomes (e.g., variables, values) in order to create a two dimensional heat map from the representative process map (e.g. map of components) (Northcott, page 1, ¶ 0008).

11. Further, in response to applicant's argument (2) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *selecting a plurality of target tasks*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
12. In response to argument (3). Examiner respectfully disagrees. this argument is moot for the following reasons: claim 23 has been rejected on new grounds in light of Applicant's amendment. Please see the rejection below.
13. In response to argument (4). Examiner respectfully disagrees. Lindsay-Scott describes collaboration between organizational group within an organization as illustrated in the figure of page 38 "collaborative technologies". Lindsay-Scott teaches that "[t]he CMA differs from traditional business consulting in that it investigates the applicability of collaborative commerce processes and technology," (e.g., identify collaborations) "performs a knowledge management assessment of cultural behaviors and draws on behavioral science (e.g., including patterns to be applied to said selected components) "for establishing better work practices" (e.g., to model how said selected components collaborate) (Lindsay-Scott, page 3, ¶ 0026).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Northcott et al (US 2003/0167198 A1) hereinafter "Northcott" in view of American Cybernetic Corporation - 2001 (http://web.archive.org/web/20011214072250/http://www.amcybernetic.com/orgdev_overview.htm) further in view of Lindsay-Scott et al (US 2004/0117234 A1) hereinafter "Lindsay-Scott".

Claim 22:

Northcott as shown discloses a method and computer product program to identify potential business opportunities, the method and computer product program comprising:

- *a computer readable medium and wherein all said program instruction means are recorded on said medium* (page 12, ¶ 0148: which teaches that "[t]he various processing modules may be implemented, in part, in a computer program product tangibly embodied in a machine-readable storage device for execution by a computer processor");
- *first program instruction means for building a map of components of activities* (page 1, ¶ 0008: "...the step of generating a map of a process for addressing the identified target customer" (e.g., client) "need state comprises identifying a representative process currently addressing the identified target customer need state and generating a map for the representative process", which teaches that a map is generated representing a process (e.g., a map of components of activities));
- *second program instructions means for filtering said map of components to form a two dimensional heat map of selected components* (page 1, ¶ 0008: "[t]he step of identifying a potential point of intervention may comprise selecting" (e.g., filtering) "a potential target task from the tasks" (e.g., a map of components of activities) in the representative process map based at least in part upon one or more of the estimated unit cost values, incidence rates, total costs, and outcomes. The potential target task may be mapped into a network of one or more sub-tasks." Northcott

teaches a selection of a potential target task based at least in part from one or more of the estimated unit cost values, incidence rates, total costs and outcomes (e.g., variables, values) in order to create a two dimensional heat map from the representative process map (e.g. map of components));

- *third program instructions means for defining attributes for said selected components, based on a competency lens*, (page 1, ¶ 0008: "[t]he potential target task may be mapped into a network of one or more subtask", by mapping the tasks of the potential target its attributes are defined. It is implicitly disclosed that the mapping is based on a competency lens since in order to be able to map it is necessary to be able to determined some sort of client/business evaluation criteria.);

Northcott teaches that "[d]uring the selection process (step 28), a subset of potential target customer need states may be selected and a respective set of one or more tasks (or procedures) may be associated" (e.g., defining attributes) "with each of the potential target customer need states" (e.g., based on a competency lens) (Northcott, ¶ 0036). Northcott does not specifically teach *said competency lens including competency offering of business strategy, information technology strategy, organizational strategy, and operations strategy*. However, American Cybernetic Corporation in an analogous art of business management for the purpose of competencies offering of business, information, organizational and operations strategies (pages 1-2, 7th ¶) as shown does:

- *said competency lens including competency offering of business strategy, information technology strategy, organizational strategy, and operations strategy* (pages 1-2, 7th ¶, which American Cybernetic Corporation teaches competency offering of business strategy (i.e., Organizational Strategy), information technology strategy (i.e., IT strategy), organizational strategy (i.e., Organizational Strategy) and operations strategy (i.e., Operations strategy));

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include competency offering of business strategy, information technology strategy, organizational strategy and operation strategy as taught by American Cybernetic Corporation, to improve Northcott, thereby giving the predictable result of analyzing "organizational change in manageable, related areas (American Cybernetic Corporation, page 1, 6th ¶).

Northcott disclose:

- *seventh program instruction means for defining a roadmap of tasks for implementing said quick hits and investment opportunities* (page 1, ¶ 0008: "[a] list of one or more projected customer needs may be generated based at least in part upon the projected customer problem list. The step of generating the projected customer needs list may comprise identifying customer needs that correspond to business opportunities for reducing cost or improving outcomes, or both" and "the step of generating the projected customer needs list may comprise identifying customer needs associated with specific tasks and focused on reducing cost or improving outcomes, or both" which teaches that in order to implement the projected customer needs, a list of task is generated (e.g., client business roadmap of tasks));

Northcott does not disclose the following limitation, however Lindsay-Scott in an analogous art of managing business operations for the purpose of identifying business critical information (page 1, ¶ 0008) as shown, does:

- *fourth program instructions means for identifying collaborations including patterns to be applied to said selected components to model how said selected components collaborate* (page 3, ¶ 0026 and 0029: which Lindsay-Scott teaches that "[t]he CMA differs from traditional business consulting in that it investigates the applicability of collaborative commerce processes and technology," (e.g., identify collaborations) "performs a knowledge management assessment of cultural behaviors and draws

on behavioral science (e.g., including patterns to be applied to said selected components) "for establishing better work practices" (e.g., to model how said selected components collaborate). Further "the CMA analyzes the role and flow of the business critical information and their associated transactions within the major value chain processes across organizational groups within the organization to develop a set of modifications to the major value chain processes for achieving an optimized flow", which teaches that analyzing the role and flow of the business critical information across the organization, any conflict between departments are analyzed, then collaborations are identified in order to accomplish a determined heat map without complications.);

- *fifth program instructions means for building a three dimensional business component solution stack using said heat map, said attributes, and said collaborations* (page 2, ¶ 0021: "[t]he Business Case development component service calculates paybacks and benefits" (e.g., variables, values) "by reviewing the current situation and identifying performance gaps. Metrics are selected and solutions" (e.g., a plurality of solution stacks) "are identified in terms of business processes and technical components and a vision is developed of the future business context", which teaches that a plurality of solutions stacks are identified based on the business' future vision, where "the solution will work in a business context, risk management and an implementation plan" (e.g., three dimensions));
- *six program instruction means for developing quick hits and investment opportunities from said solution stack* (page 2, ¶ 0019: "The Content Strategy development component service is used to identify, prioritize and manage content-related initiatives—highlighting opportunities, summarizing benefits and planning project implementation", which teaches that this component identify opportunities, since it is implicitly disclosed that opportunities can be short or long term projects depending of the business' need);

- *and eighth program instruction means for implementing said roadmap for said business* (page 2, ¶ 0019: "[0019] The Content Strategy development component service is used to identify, prioritize and manage content-related initiatives--highlighting opportunities, summarizing benefits and planning project implementation. The Content Strategy service helps clients to identify and manage a program of content-related initiatives across their organization, including the business case, prioritization and implementation planning" which teaches that the Content Strategy development component service is use to implement the planning project, since it is implicitly disclosed that in order to implement a project, a detailed plan must be determined);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the identifying potential business opportunities method of Northcott and the strategic analysis of American Cybernetic Corporation with the system and method for content management assessment as taught by Lindsay-Scott because "the system and method for CMA can provide customer benefits such as: identifying solutions and an action plan for: reducing time to market; faster and higher quality customer responses; lower transaction costs due to improved communication; more relevant, timely and accurate information; more repurposing of flexible content through inter-system communication; information sharing at lower cost; multi-sourced information personalized through a single access point; conformance information as a product of normal business processes." (Lindsay-Scott, page 4, ¶ 0030).

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nadja Chong** whose telephone number is **570.270.3939**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **BETH BOSWEL** can be reached at **571.272.6737**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Art Unit: 3623

Commissioner of Patents

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or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

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